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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 19

Application Number: 09/334,256

Filing Date: June 16, 1999

Appellant(s): RICHARDSON ET AL.

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Jon D. Grossman  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/09/2002.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The Appellants' statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The Appellants' brief includes a statement that claims 1-4 and 7-23 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Appellants' Affidavit of Commercial Success***

Receipt is acknowledged for Appellants' Affidavit of Commercial Success under 37 CFR 1.132 (see Paper #18), filed on 04/09/2002. However, such affidavit has not been seasonably filed pursuant to MPEP 716.01(A). This Affidavit has been placed of record in the case; however, it has not been considered.

**(9) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(10) Prior Art of Record**

Duncan, William R.; "A Guide To The Project Management Body of Knowledge;" PMI Standards Committee, Project Management Institute, 1996

**(11) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4 and 7-23 were rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 12, and repeated below:

1. Claims 1-4 and 7-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over William R. Duncan, "A Guide to the Project Management Body of Knowledge," Project Management Institute, 1996 (hereafter referred to as **Duncan**).

2. Appellant has become his own lexicographer and defined his own terms for features of his invention. For clarity and use in this examination, Examiner uses the following definitions for the indicated terms, based on their definition/discussion in the specification:

- **tasking horizon** - a window of time over which tasks can be scheduled (pg. 11).

Examiner interprets this to be synonymous with *the duration of time included in the planned time span defined by the task start and stop dates*.

- **verb** - designed to capture the type of dialogue that a worker would use to explain why a task was or was not started and/or completed as planned (pg. 12), or

Art Unit: 3625

used to classify the reasons for churn, or in other words the reason for why the task was performed as planned or not performed as planned (pg. 14).

- **churn** - the movement of tasks in relation to the tasking horizon (pg. 8), or the difference between the planned start and stop dates and the actual start and stop dates (pg. 14)..

Claim 1: **Duncan** discloses:

- breaking a project into multiple tasks (pg. 30-32, para. 3.3.2; pg. 59, para. 6.1);
- activating a current tasking horizon (pg. 30-32, para. 3.3.2; pg. 170 ), described as target finish date and schedule development;
- selecting a language for at least one of said multiple tasks (pg. 46, para. 4.3.3.3), where verbs and language are encompassed by lessons learned;
- receiving an actual date for at least one of said multiple tasks (pg. 31; fig. 3-5. [6.4]; pg. 159), which is disclosed as schedule development, activity definition and actual start date;
- receiving an estimated date for said at least one task (pg. 31; fig. 3-5 [6.3]), which is disclosed as activity duration estimating; and
- receiving language that corresponds to said actual date, wherein a verb describes a reason for said actual date and for said churn (pg. 108 para. 10.3.2), in analyses involving comparing actual project results to planned or expected results.

**Duncan** does not specifically disclose calculating a first negative churn if said received estimated date is created in or moved into said current tasking horizon;

calculating a first positive churn if said estimated date is deleted or moved out of said current tasking horizon; calculating a second positive churn if said received estimated date exists in said current tasking horizon and said received actual date is moved out of or is created outside of said current tasking horizon; nor calculating a third positive churn if said received actual date is moved out of or is created outside of said current tasking horizon and an accompanying received estimated date is not in said current tasking horizon.

However, **Duncan** discloses tools to perform variance analysis involving comparing actual project results to planned or expected results, trend analysis, earned value analysis, performance reports, change requests (pg. 30-32 para. 3.3.2-3.3.4; pg. 41-42, para. 4.1.3; pg. 107-109 para. 10.3-10.3.3; pg. 110, fig. 10-3; pg. 113, para. 11.1.1). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify **Duncan** to disclose the functionality necessary to calculate a first negative churn if said received estimated date is created in or moved into said current tasking horizon; calculate a first positive churn if said estimated date is deleted or moved out of said current tasking horizon; calculate a second positive churn if said received estimated date exists in said current tasking horizon and said received actual date is moved out of or is created outside of said current tasking horizon; and calculate a third positive churn if said received actual date is moved out of or is created outside of said current tasking horizon and an accompanying received estimated date is not in said current tasking horizon, through the performance reporting mechanisms provided by the invention of **Duncan**, since they are already encompassed by **Duncan**.

Claim 2: **Duncan** discloses classifying said received verb as employee dependent (pg. 95, para. 9.1.1.2-3).

Claim 3: **Duncan** discloses classifying said received verb as task dependent (pg. 61-62 para. 6.1.3).

Claim 4: **Duncan** discloses classifying said received verb as environment dependent (pg. 61-62 para. 6.1.3).

Claim 7: **Duncan** discloses:

- comparing said tasks of said project to previously performed tasks (pg. 113, para. 11.1.1.3);
- extracting previously performed task completion data (pg. 113, para. 11.1.1.3);

and

- computing an expected task completion time based at least in part on said previously performed task completion data (pg. 113, para. 11.1.1.1-3).

Claim 8: **Duncan** discloses

- comparing said tasks of said project to previously performed tasks (pg. 113, para. 11.1.1.3);
- extracting a risk factor associated with said previously performed tasks (pg. 113, para. 11.1.1.3); and

Art Unit: 3625

- computing a risk factor based at least in part on said extracted risk factor (pg. 115-117, para. 11.2; fig. 11-2).

Claims 9 and 23: **Duncan discloses:**

- breaking a project into multiple tasks (pg. 30-32, para. 3.3.2; pg. 59, para. 6.1);
- selecting a current tasking horizon (pg. 30-32, para. 3.3.2; pg. 170 ), described as target finish date and schedule development;
- selecting at least two verbs for said first task (pg. 46, para. 4.3.3.3), where verbs and language are encompassed by lessons learned;
- selecting at least two verbs for said second task (pg. 46, para. 4.3.3.3), where verbs and language are encompassed by lessons learned;
- assigning said first task to a first task assignment station (pg. 97, para. 9.1.3.1-4);
- assigning said second task to a second task assignment station (pg. 97, para. 9.1.3.1-4);
- receiving a predicted start date and a predicted completion date for said first task from said first task assignment station (pg. 31; fig. 3-5 [6.3]), which is disclosed as activity duration estimating;
- receiving a predicted start date and a predicted completion date for said second task from said second task assignment station (pg. 31; fig. 3-5 [6.3]), which is disclosed as activity duration estimating;

Art Unit: 3625

- receiving an actual start date and a verb for said first task (pg. 31; fig. 3-5 [6.4]; pg. 159), which is disclosed as schedule development, activity definition and actual start date; and
- receiving an actual start date and a verb for said second task (pg. 31; fig. 3-5 [6.4]; pg. 159), which is disclosed as schedule development, activity definition and actual start date.
- comparing said predicted start and stop dates with said actual start and stop dates (pg. 107-108, para. 10.3; pg. 109 fig. 10-2; pg. 110 fig. 10-3; pg. 113, para. 11.1.1);
- computing a risk factor for said first task (pg. 115-118, para. 11.2; fig. 11-1; fig. 11-2); and
- computing a risk factor for said second task (pg. 115-118, para. 11.2; fig. 11-1; fig. 11-2).

Duncan does not specifically disclose computing churn of said first task, or computing churn for said second task. However, **Duncan** does disclose the functionality for computing churn for said tasks (pg. 107-108, para. 10.3; pg. 109 fig. 10-2; pg. 110 fig. 10-3; pg. 113, para. 11.1.1). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify **Duncan** to specifically disclose computing churn of said first task, and computing churn for said second task, because **Duncan** does disclose the necessary functionality for these

computations and these specific features may enhance the desirability of the invention to potential users.

Claim 10 and 22: **Duncan** discloses:

- a management module for:
  - breaking a project into tasks (pg. 30-32, para. 3.3.2);
  - selecting a tasking horizon (pg. 30-32, para. 3.3.2; ), through schedule development; and
    - assigning at least two verbs for at least one of said tasks (pg. 30-32, para. 3.3.2), through activity definition and activity sequencing;
- a task assignment station (pg. 96, fig. 9-2) for:
  - receiving said at least one task (pg. 42, para. 4.21.3), through responsibility assignments and project planning;
  - entering a predicted start date and stop date for said at least one task (pg. 42, para. 4.21.3), through establishing a scheduled start date; and
    - entering an actual start date and stop date (pg. 157; pg. 159; pg. 70; fig. 6-7 and 6-8), through representation of activity/project dates on graphs and charts;
- said management module and said assignment station are operationally connected (pg. 8-9-10, para. 1.4-5; fig. 1-2); and
- said management module:
  - receives predicted start and stop dates and said actual start and stop dates (pg. 31; fig. 3-5 [6.3]; pg. 31; fig. 3-5 [6.4]; pg. 159); and

-- computes a churn (pg. 107-108, para. 10.3; pg. 109 fig. 10-2; pg. 110 fig. 10-3; pg. 113, para. 11.1.1); and

- -- assigns a risk factor to said task based on at least one of said verbs having a reason associated therewith used to describe said churn (pg. 61 para. 6.1.1; pg. 115-118, para. 11.2; fig. 11-1; fig. 11-2).

Duncan does not specifically disclose computing churn. However, **Duncan** does disclose the functionality for computing churn (pg. 107-108, para. 10.3; pg. 109 fig. 10-2; pg. 110 fig. 10-3; pg. 113, para. 11.1.1). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify **Duncan** to specifically disclose computing churn, because **Duncan** does disclose the necessary functionality for this computation and this specific feature may enhance the desirability of the invention to potential users.

Claim 11: **Duncan** discloses modifying said computed risk factor based on a subsequent churn value (pg. 165), through mitigation.

Claim 12: **Duncan** discloses said method results in a reduction of said churn (pg. 165), through mitigation.

Claim 13: **Duncan** discloses said actual dates comprise an actual start date and an actual stop date (pg. 159).

Claim 14: **Duncan** discloses said received estimated dates comprise an estimated start date and an estimated stop date (pg. 169-170).

Claim 15: **Duncan** does not specifically disclose assigning a risk factor to a second task which is dependent upon a first task. **Duncan** does disclose risk is interrelated with scheduled events (pg. 30-32, para. 3.3.2). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Duncan to use a risk factor equal to a percentage of the time between said predicted start and stop dates (or various other representations to portray task interdependencies, as may be required by a user), because this is an obvious variation that is encompassed by the Duncan invention.

Claim 16: **Duncan** discloses said second task is dependent on said first task (pg. 30 para. 3.3.2), through the functionality of relationships of planning processes.

Claim 17: **Duncan** discloses:

- breaking a project into multiple tasks (pg. 30-32, para. 3.3.2; pg. 59, para. 6.1);
- selecting a current tasking horizon (pg. 30-32, para. 3.3.2; pg. 170 ), described as target finish date and schedule development;
- selecting at least two verbs for at least one of said task (pg. 46, para. 4.3.3.3), where verbs are encompassed by lessons learned;

- receiving a predicted start date and a predicted stop date for said first task for at least one task (pg. 31; fig. 3-5 [6.3]), which is disclosed as activity duration estimating;
- receiving an actual start date and a verb for said at least one task (pg. 31; fig. 3-5 [6.4]; pg. 159), which is disclosed as schedule development, activity definition and actual start date; and
- receiving one of at least two verbs that corresponds to said actual start and stop dates, wherein said verb describes at least one reason for said actual start and stop dates (pg. 31; fig. 3-5 [6.4]; pg. 159), which is disclosed as schedule development, activity definition and actual start date;
- comparing said predicted start and stop dates with said actual start and stop dates (pg. 107-108, para. 10.3; pg. 109 fig. 10-2; pg. 110 fig. 10-3; pg. 113, para. 11.1.1);
- computing churn of at least one task (pg. 107-108, para. 10.3; pg. 109 fig. 10-2; pg. 110 fig. 10-3; pg. 113, para. 11.1.1);
- reviewing said churn in view of at least one verb and assigning a risk factor to said task based on said review (pg. 30-32, para. 3.3.2; pg. 115-118, para. 11.2; fig. 11-1; fig. 11-2).

Duncan does not specifically disclose computing churn of at least one task. However, **Duncan** does disclose the functionality for computing churn of at least one task (pg. 107-108, para. 10.3; pg. 109 fig. 10-2; pg. 110 fig. 10-3; pg. 113, para. 11.1.1). Therefore, it would have been obvious to one skilled in the art at the time the invention

was made to modify **Duncan** to specifically disclose computing churn of at least one task, because **Duncan** does disclose the necessary functionality for this computation and this specific feature may enhance the desirability of the invention to potential users.

Claim 18: **Duncan** does not specifically disclose said risk factor is equal to a percentage of the time between said predicted start and stop dates. **Duncan** does disclose risk is interrelated with scheduled events (pg. 30-32, para. 3.3.2). It would have been obvious to one skilled in the art at the time the invention was made to modify **Duncan** to use a risk factor equal to a percentage of the time between said predicted start and stop dates, because this is an obvious variation that is encompassed by the **Duncan** invention and may provide additional clarity for scheduling- and risk-related activities.

Claim 19: **Duncan** discloses said previous risk factor is task dependent (pg. 30-32, para. 3.3.2; pg. 115-118 para. 11.2; fig. 11-1; fig. 11-2).

Claim 20: **Duncan** does not specifically disclose said apparatus classifies said churn as positive churn or negative churn. **Duncan** does disclose the functionality encompassed by said apparatus classifies said churn as positive churn or negative churn (pg. 30-32 para. 3.3.2; pg. 108 para. 10.3.1; pg. 115-118 para. 11.2; fig. 11-1; fig. 11-2), through the mechanisms of variance analysis, trend analysis, and schedule variance.

Claim 21: **Duncan** discloses said apparatus is utilized in a churn monitoring program to reduce said churn (pg. 108 para. 10.3.1; pg. 115-118 para. 11.2; pg. 165; fig. 11-1;

fig. 11-2), through at least the processes of variance analysis, trend analysis, earned value analysis, and mitigation.

**(12) Response to Argument**

The Appellant's arguments filed on 04/09/2002 (see Paper #17) have been fully considered but they are not persuasive. The Examiner's answer to the Appellants' arguments follows:

i. The Appellants argue at pg. 8 that, *in the Final Rejection, several terms contained within the present invention were listed and approximate definitions were made for those terms (Final Office Action, page 5, section 12)*. However, *the definitions of tasking horizon, verb, and churn are incomplete and an oversimplification of how they are described in the instant specification*.

*Specifically, the definition of tasking horizon supplied by the Office Action is incomplete/inaccurate in that it does not mention the farthest point in time in the future where a manager believes a task will be completed as planned (specification, table page 9). Instead, the Final Office Action mistakenly defines tasking horizon as a window of time over which tasks can be scheduled, or (alternatively) the duration of time included in the planned time span defined by the task start and stop dates (Final Office Action, page 5, section 12, paragraph 2). Neither of the alternatives are consistent with the definition provided in the specification.*

*Additionally, the Office Action's definition of verb is also incomplete. That definition mentions reasons for churn and why a task was performed as planned or not, but does not mention requiring the employee to select a verb so as to facilitate the standardization of employee/employer dialogue so that it is capable of analysis (specification, page 14, lines 5-7). Finally, the definition of churn supplied by the Office Action (page 5, section 12) is incomplete. That definition mentions movement of tasks in relation to a tasking horizon and the difference between planned start and stop dates, but does not mention measuring the predictive ability of an employee (specification, page 14, lines 15-17). While the Examiner is permitted to provide the broadest interpretation possible, it cannot be done without applying those limitations already set forth in the specification.*

**The Examiner disagrees.** The Examiner maintains that the definitions presented by Examiner are consistent with the disclosure in the specification. While the Examiner did not copy the entire specification into the definitions presented in the Final Action, the Examiner did extract definitions from the specification. The definition of tasking horizon was extracted from pg. 11, last paragraph, lines 22-26. The definition of ~~verb, but did not define~~ churn was extracted from the table presented on pg. 8, which presents the Appellants' terms and definitions, and, alternatively, from pg. 14 in lines 10-11. The definition of verb was extracted from pg. 12 in lines 17-18, and from pg. 14 in lines 12-13. The Examiner used these definitions in his examination of the Appellants' application, and considers them both adequate and appropriate.

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ii. The Appellants argue, at pg. 9, that *throughout the prosecution of this application, the various Office Actions repeatedly make a summary conclusion that it would have been obvious to one of ordinary skill in the art to modify the system of Duncan. Applicants respectfully disagree with these conclusions. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. See In re Fine, 837 F.2d 1071 (Fed. CIT. 1988). No such teaching, suggestion or motivation is present in Duncan. Without using the present claims as a road map, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention. The rejection uses impermissible hindsight to reconstruct the present invention from Duncan. See Ex parte Clap, 227 U.S.P.Q. 972, 972 (Bd. App. 1985) (requiring "convincing line of reasoning" to support obviousness determination).*

*The Office Actions have consistently dismissed Applicants' arguments without addressing their merits by stating that although Duncan does not necessarily use the same terminology, it is obvious that the invention is disclosed by Duncan (Final Office Action, Response to Arguments, pages 16-17). However, the Office Action mischaracterizes terms from how they are defined in the specification, supplies teachings in Duncan that do not correspond to the claims, and appears to use the instant claims as a roadmap to supply missing elements in Duncan. The fact that the present invention was made by Applicants does not make the present invention obvious; that suggestion or teaching must come from the prior art. See C-R Bard, Inc. v. M3 Systems, 157 F. 3d 1340, 1352 (Fed. Cir. 1998).*

**The Examiner disagrees.** The Appellants' allegations of summary conclusions and failure to provide suggestions or motivation to expound on that which is already disclosed by Duncan is not persuasive.

The Examiner has acknowledged that Duncan is silent to explicit characterizations of the Appellants' recited invention (i.e., verb, churn, tasking horizon, etc.). However, the Examiner, in consideration of such terms, and in view of that which is explicit in or reasonably inferable from Duncan, has cited passages in Duncan which provide functionality that minimally one of ordinary skill in the art is able to ascertain through reasonable inference or interpretation.

In that the Examiner has relied upon the skilled artisan's reasonable treatment of the cited passages, the Examiner has in no manner relied upon a reconstruction of the present invention by employing impermissible hindsight.

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*iii. The Appellants argue, on pg. 10-11, *Independent claims 9, 10, 17, 22 and 23 contain many of the same steps set forth in claim 1 above. The Final Office Action only peripherally addresses the claimed step of "selecting a language for at least one of said multiple tasks" highlighted above, applying Duncan's "lessons learned" (page 6, lines 9-10, citing to Duncan's page 46, paragraph 4.3.3.3). Selecting a language provides a medium through which structured verbs, objects, project phase definitions, and tasking horizons can be communicated (specification, table of definitions spanning pages 7, 8). The structured verb language can also be used within the modeling module for tasks**

*regardless of the project in which they were originally planned or performed.* Conversely, Duncan's "lessons learned" refer only obliquely to documenting causes of variances in a historical database, and only anticipates lessons learned for the just-completed project. Also, Duncan's historical database contains no suggestion for selecting a language for verbs, objects, and project phase definitions and tasking horizons (as claimed). Furthermore, this discrepancy was not addressed anywhere else in the Final Office Action.

**The Examiner disagrees.** Duncan discloses at 4.3.3.3:

*Lessons learned. The causes of variances, the reasoning behind the corrective action chosen, and other types of lessons learned should be documented so that they become part of the historical database for both this project and other projects of the performing organization.*

The Examiner maintains that the documentation of the lessons learned encompasses *selecting a language for at least one of said multiple tasks*. Additionally, Duncan presents his invention using terms which he defines on pg. 159-171. Through the use of the disclosure, Duncan provides the functionality that encompasses *selecting a language for at least one of said multiple tasks*. Specifically, the identification and use of definitions for terms used in the disclosure of Duncan constitute *selecting a language*.

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iv. At pg. 11 in the 3<sup>rd</sup> paragraph, the Appellants argue:

- *For suggesting the claimed first and second negative and positive churns highlighted above, the Final Office Action relies on Duncan's tools to perform variance*

*analysis (Final Office Action, page 7, paragraph 2, citing to Duncan pp. 30, 32, 41-42, 107-109, 110 and 111). This aspect of the rejection is respectfully traversed.*

*In particular, Duncan's variance analysis tools are not (1) disclosed as describing the movement of tasks in relation to a tasking horizon, or (2) do not measure the predictive ability of an employee (specification, page 14, lines 15-17). Instead, Duncan's variance analysis tools are described as comparing actual project results to planned or expected results (page 108, section 10.3.2.2), and make no allusion to being broken down to a per-task level of granularity.*

**The Examiner disagrees.** Duncan does disclose the invention, as follows:

*Project performance must be measured regularly to identify variances from the plan. Variances are fed into the control processes in the various knowledge areas. To the extent that significant variances are observed (i.e., those that jeopardize the project objectives), adjustments to the plan are made by repeating the appropriate project planning processes. For example, a missed activity finish date may require adjustments to the current staffing plan, reliance on overtime, or trade-offs between budget and schedule objectives. Controlling also includes taking preventive action in anticipation of possible problems (pg. 32 para. 3.3.4).*

Thus, Duncan provides per-task level of granularity through the context of a *missed activity finish date may require adjustments*, as the terms *activity* and *task* may be interchangeable with regard to the disclosure of Duncan.

- *Duncan's variance analysis tools are not (1) disclosed as describing the movement of tasks in relation to a tasking horizon, or (2) do not measure the predictive ability of an employee (specification, page 14, lines 15-17).*

**The Examiner disagrees.**

Duncan discloses *Project performance must be measured regularly to identify variances from the plan. Variances are fed into the control processes in the various knowledge areas. To the extent that significant variances are observed (i.e., those that jeopardize the project objectives), adjustments to the plan are made by repeating the appropriate project planning processes. For example, a missed activity finish date may require adjustments to the current staffing plan, reliance on overtime, or trade-offs between budget and schedule objectives. Controlling also includes taking preventive action in anticipation of possible problems (pg. 32 para. 3.3.4).* This disclosure encompasses (1) *describing the movement of tasks in relation to a tasking horizon.*

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- *Duncan's variance analysis tools are described as comparing actual project results to planned or expected results (page 108, section 10.3.2.2), and make no allusion to being broken down to a per-task level of granularity.*

**The Examiner disagrees.** The Examiner cited Duncan pp. 30-32, 41-42, 107-109, 110 and 113 in the rejection. Duncan discloses, on pg. 31, *Schedule Development (6.4)-analyzing activity sequences, activity durations, and resource requirements to create the project schedule* which encompasses being broken down to

a per task level of granularity, where Duncan describes the word *activity* as it relates to the word *task* on pg. 59, and used in the disclosure of Duncan.

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v. The Appellants argue, on pg. 11 in the 3<sup>rd</sup> paragraph, *Also, as described above, the definition of churn supplied by the Office Action (page 5, section 12) is incomplete in that it does not teach or suggest measuring the predictive ability of an employee, and the later portions of the rejection do not address this deficiency. This feature is also found in claims 1, 9, 10, 17, 22 and 23.*

**The Examiner disagrees.** The Examiner uses a definition of *churn* obtained from the Appellants' specification (i.e., churn - the movement of tasks in relation to the tasking horizon (see specification at pg. 8), or the difference between the planned start and stop dates and the actual start and stop dates (see specification at pg. 14, lines 10-11).

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vi. The Appellants argue, at pg. 11 last paragraph, *In addition, the Final Office Action does not address the step of "receiving language that corresponds to said actual date, wherein a verb describes a reason for said actual date and for said churn" also as highlighted above. The rejection states only that these elements can be found in Duncan at page 108, paragraph 10.3.2 (Office Action, page 6, section 13). However there is nothing in the referenced page and paragraph that illustrates the above-noted limitations. Moreover, there is no corresponding explanation supplied in the Final Office Action. Having no other information as guidance to the reasoning of the Examiner, it*

*will be assumed that Duncan's performance reviews and variance analysis are somehow intended to correspond with the claimed verbs. However, Duncan's performance reviews are described as meetings held to assess project status or progress including using variance analysis to compare actual project results with planned or expected results (page 108, paragraphs 10.3.2.1). Conversely, the claimed verbs are described as a series of potential answers to standard questions, such as why did someone perform this task faster or slower than estimated, where those verbs can be broken down into separate categories (col. 6, lines 17-22). Duncan's performance reviews and variance analysis do not teach or suggest the claimed verbs as defined in the specification. Verbs are also explicitly recited in claims 1, 9, 10, 17, 22 and 23.*

**The Examiner disagrees.** Duncan discloses:

- Performance reviews are meetings held to assess project status or progress.

Performance reviews are typically used in conjunction with one or more of the performance reporting techniques described below (page 108, paragraphs 10.3.2.1).

- Variance analysis involves comparing actual project results to planned or expected results (page 108, paragraphs 10.3.2.1).
- Trend analysis involves examining project results over time to determine if performance is improving or deteriorating (page 108, paragraphs 10.3.2.2).

The Examiner maintains that these activities provide the analyses necessary to determine the status, schedule, and reasoning for the current and projected results of activities, and encompass the invention of the Appellants. Duncan also discloses Cost

*estimates, scheduled start dates, and responsibility assignments to the level of the WBS at which control will be exercised (pg. 42 para. 4.1.3.1). Additionally, the disclosure of Duncan uses descriptive words/terms/phrases, the definitions of which are described in Duncan at pg. 159-171. The Appellants' statements that Duncan does not disclose a particular feature is true ONLY if the reader does not negotiate the meaning/definition of the words/features of Duncan with the meaning/definition of the words/features of the Appellants.*

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*vii. The Appellants argue, at pg. 12, Claim 2 recites the step of classifying a received verb as being employee dependent. In response, the Final Office Action asserted that Duncan's staffing requirements and organizational constraints (page 8, citing Duncan's page 95, paragraph 9.1.1.2-3) correspond to the claimed element. This assertion is respectfully traversed. Duncan's staffing requirements and organization constraints are not described as being a sub-category of a verb, or a series of potential answers to specific questions. For at least the above reasons, the rejection of claim 2 should be withdrawn.*

**The Examiner disagrees.** Duncan discloses:

- Staffing requirements define what kinds of skills are required from what kinds of individuals or groups and in what time frames. Staffing requirements are a subset of the overall resource requirements identified during resource planning (described in Section 7.1).

Art Unit: 3625

- Constraints are factors that limit the project team's options. A project's organizational options may be constrained in many ways. Common factors that may constrain how the team is organized include, but are not limited to, the following:

-- Organizational structure of the performing organization-an organization whose basic structure is a strong matrix means a relatively stronger role for the project manager than one whose basic structure is a weak matrix (see Section 2.3.3 for a more detailed discussion of organizational structures).

-- Collective bargaining agreements- contractual agreements with unions or other employee groups may require certain roles or reporting relationships (in essence, the employee group is a stakeholder).

-- Preferences of the project management team- if members of the project management team have had success with certain structures in the past, they are likely to advocate similar structures in the future.

-- Expected staff assignments- how the project is organized is often influenced by the skills and capabilities of specific individuals.

Duncan thus discloses that inputs to projects (which normally consist of activities and/or tasks) are often influenced by the skills and capabilities of specific individuals or employee groups, and thus, could be employee dependent. Additionally, the descriptions in Duncan apply the definitions provided by Duncan beginning on pg. 59. These definitions include (from pg. 169):

- Resource Leveling. Any form of network analysis in which scheduling decisions (start and finish dates) are driven by resource management concerns (e.g., limited resource availability or difficult-to-manage changes in resource levels).
- Resource-Limited Schedule. A project schedule whose start and finish dates reflect expected resource availability. The final project schedule should always be resource-limited.
- Resource Planning. Determining what resources (people, equipment, materials) are needed in what quantities to perform project activities.

The Examiner maintains that these disclosures provide potential answers to specific questions pertaining to how to staff an activity/project in order to accomplish the objectives or satisfy the requirements of the activity/project. In determining staffing requirements, the Examiner maintains that Duncan associates requirements and activities with descriptive terms that encompass the Appellants' verbs.

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viii. The Appellants argue at pg. 13, *Claims 3 and 4 recite the steps of classifying a received verb as being task-dependent and environment-dependent, respectively. In response, the Final Office Action asserted that Duncan's activity list and supporting detail (page 8, citing Duncan's pp. 61-62, paragraph 6.1.3) correspond to the claimed element. This assertion is also respectfully traversed. The activity list and supporting detail is not described anywhere within Duncan as a sub-category of verb or series of potential answers to specific questions. For at least the above reasons, the rejection of claims 3 and 4 should be withdrawn.*

**The Examiner disagrees.** Duncan states:

- Historical information (what activities were actually required on previous, similar projects) should be considered in defining project activities (para. 6.1.1.3.)

- The activity list must include all activities which will be performed on the project.

It should be organized as an extension to the WBS to help ensure that it is complete and that it does not include any activities which are not required as part of the project scope. As with the WBS, the activity list should include descriptions of each activity to ensure that the project team members will understand how the work is to be done (pg. 61 para. 6.1.3.1).

- Supporting detail for the activity list should be documented and organized as needed to facilitate its use by other project management processes. Supporting detail should always include documentation of all identified assumptions and constraints. The amount of additional detail varies by application area (pg. 61 para. 6.1.3.2).

- In using the WBS to identify which activities are needed, the project team may identify missing deliverables or may determine that the deliverable descriptions need to be clarified or corrected. Any such updates must be reflected in the WBS and related documentation such as cost estimates. These updates are often called refinements and are most likely when the project involves new or unproven technology (pg. 62 para. 6.1.3.3).

- Lessons learned. The causes of variances, the reasoning behind the corrective action chosen, and other types of lessons learned should be documented so that they

become part of the historical database for both this project and other projects of the performing organization (pg. 46 para. 4.3.3.3).

- Performance reporting involves collecting and disseminating performance information in order to provide stakeholders with information about how resources are being used to achieve project objectives. This process includes:
  - \* Status reporting- describing where the project now stands.
  - \* Progress reporting- describing what the project team has accomplished.
  - \* Forecasting- predicting future project status and progress.

Performance reporting should generally provide information on scope, schedule, cost, and quality. Many projects also require information on risk and procurement.

Reports may be prepared comprehensively or on an exception basis. (pg. 107 para. 10.3)

The Examiner maintains that the functionality of the disclosure of Duncan encompasses the claimed features of *classifying a received verb as being task-dependent and environment-dependent* through WBS updates, lessons learned, and performance reporting. Also, the Appellants argue that *the activity list and supporting detail is not described anywhere within Duncan as a sub-category of verbs or series of potential answers to specific questions*. While Duncan does not explicitly use the terms used by the Appellants, Duncan does use terms that provide the functionality of the Appellants' invention. These terms are defined in Duncan at Glossary, para. 3. Additionally, the Examiner maintains that the lessons learned provides the functionality of the Appellants' claimed aspects.

ix. The Appellants argue, at pg. 13 in 2<sup>nd</sup> paragraph, *Claims 9 and 23 recites the step of selecting at least two verbs for a task. In response, the Final Office Action asserted that Duncan's lessons learned (page 9, citing Duncan's page 46, paragraph 4.3.3.3) correspond to the claimed element. This assertion is respectfully traversed. Duncan's lessons learned are not described as being a series of potential answers to specific questions. For at least the above reasons, the rejection of claims 9 and 23 should be withdrawn.*

**The Examiner disagrees.** Duncan discloses at pg. 46, para. 4.3.3.3:

- *Lessons learned. The causes of variances, the reasoning behind the corrective action chosen, and other types of lessons learned should be documented so that they become part of the historical database for both this project and other projects of the performing organization.*

The Examiner maintains that *the step of selecting at least two verbs for a task* is analogous to documenting (which requires the act of selecting) the causes of variances, the reasoning behind the corrective action chosen, and other types of lessons learned. Selecting a verb encompasses selecting descriptive text that describes the status of an activity, task or program.

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x. The Appellants argue, at pg. 13-14, *Claims 10 and 22 recite an apparatus for task modeling, a management module within that apparatus, and a task management station. The task modeling apparatus incorporates statistical modeling features which*

*become important when a user wishes to plan for future projects. Several of these statistical modeling features are shown in the specification on page 12, lines 1-5, and also lines 15-19. The Final Office Action did not directly address either of these elements, or which part of Duncan corresponds thereto.*

**The Examiner disagrees.** Duncan discloses:

- a management module (pg. 30-32, para. 3.3.2),
- the functionality of a task assignment station (pg. 96 [Figure 9-2]; pg. 96-98, para. 9.1.3); and
- the use of statistical analysis and modeling features in his invention (pg. 112, Table 11-1, 11.2.2.2; pg. 115, para. 11.2; pg. 117, para. 11.2.2.2-3; pg. 166 [Parametric Estimating]).

The Examiner also points out that neither the specification nor the claims present a *task management station*. The specification and claims do address a *task assignment station*. Also, the claims do not specifically address the use of statistical modeling or statistical modeling features. The specification does identify the use of statistical information that has been gathered in the past (pg. 22), and the possible use of statistical data analysis and pattern recognition methods (pg. 23). The Examiner maintains that Duncan discloses the features and functionality of the Appellants' invention as claimed.

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xi. The Appellants argue, on pg. 15-17, *The Final Office Action concludes that it would have been obvious to modify Duncan to disclose the functionality necessary to calculate churn . . . through the performance reporting mechanisms of Duncan, since they are already encompassed by Duncan (Final Office Action, page 7, 2nd paragraph, emphasis added)*. There is no factual or legal basis for this conclusion. While Duncan broadly recites general ideas about management, it does not suggest the computing of positive and negative churn as claimed using the terms as defined in the specification.

*Similarly, the Final Office Action also states it would have been obvious to modify Duncan to specifically disclose computing churn because Duncan discloses the necessary functionality, . . . and these specific features may enhance the desirability of the invention (page 10, bottom paragraph). Making alterations to a reference to "enhance the desirability of an invention" is not a sufficient motivation to sustain a rejection under 35 U.S.C. §103. It is unsupported conjecture, not a prima facie basis for non-obviousness. The same is true for being "already encompassed" within Duncan. If it is certain that Duncan "already encompasses" the claimed invention, then the specific teachings provided by Duncan need to be shown. These teachings to do not exist.*

*Throughout the prosecution of this application, the various Office Actions repeatedly make a summary conclusion that it would have been obvious to one of ordinary skill in the art to modify the system of Duncan. Applicants respectfully disagree with these conclusions. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some*

*teaching, suggestion, or motivation to do so. See In re Fine, 837 F.2d 1071 (Fed. Cir. 1988). No such teaching, suggestion or motivation is present in Duncan. Without using the present claims as a road map, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention. The rejection uses impermissible hindsight to reconstruct the present invention from Duncan. See Ex parte Clapp, 227 U.S.P.Q. 972, 972 (Bd. App. 1985) (requiring "convincing line of reasoning" to support obviousness determination).*

*The Office Actions have consistently dismissed Applicants' arguments without addressing their merits by stating that although Duncan does not necessarily use the same terminology, it is obvious that the invention is disclosed by Duncan (Final Office Action, Response to Arguments, pages 16-17). However, the Office Action mischaracterizes terms from how they are defined in the specification, supplies teachings in Duncan that do not correspond to the claims, and appears to use the instant claims as a roadmap to supply missing elements in Duncan. The fact that the present invention was made by Applicants does not make the present invention obvious; that suggestion or teaching must come from the prior art. See C. R. Bard, Inc-v\_. M3Sys\_tems, 157 F.3d 1340, 1352 (Fed. Cir. 1998). For at least the above reasons, the rejection of claims 1-4 and 7-37 should be withdrawn.*

**The Examiner disagrees.** The Appellants' allegations of summary conclusions and failure to provide suggestions or motivation to expound on that which is already disclosed by Duncan is not persuasive.

The Examiner has acknowledged that Duncan is silent to explicit characterizations of the Appellants' recited invention (i.e., verb, churn, tasking horizon, etc.). However, the Examiner, in consideration of such terms, and in view of that which is explicit in or reasonably inferable from Duncan, has cited passages in Duncan which provide functionality that minimally one of ordinary skill in the art is able to ascertain through reasonable inference or interpretation.

In that the Examiner has relied upon the skilled artisan's reasonable treatment of the cited passages, the Examiner has in no manner relied upon a reconstruction of the present invention by employing impermissible hindsight.

Additionally, Duncan discloses *These three values are used in combination to provide measures of whether or not work is being accomplished as planned. The most commonly used measures are the cost variance (CV = BCWP - ACWP), the schedule variance (SV = BCWP - BCWS),...* (pg. 108 para. 10.3.2.4), which discloses, in combination with the above cited passages in Duncan, the functionality to suggest the computing of positive and negative churn (i.e., schedule variance) as claimed using the terms as defined in the specification.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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June 17, 2002

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# Attachment for PTO-948 (Rev. 03/01, or earlier)

6/18/01

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

## **INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

### **1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTO-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

### **2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction or informalities, unless the examiner has approved the proposed changes.

#### **Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.

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